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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/915,133	07/25/2001	Michael John Dixon	LE9-00-083	6435
21972	7590	09/17/2004	EXAMINER	
LEXMARK INTERNATIONAL, INC. INTELLECTUAL PROPERTY LAW DEPARTMENT 740 WEST NEW CIRCLE ROAD BLDG. 082-1 LEXINGTON, KY 40550-0999			DONOVAN, LINCOLN D	
			ART UNIT	PAPER NUMBER
			2832	
DATE MAILED: 09/17/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/915,133

Applicant(s)

DIXON ET AL. 

Examiner

Lincoln Donovan

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, in lines 2-3, it is not clear what applicant intends by "said roller having up to 12 percent less weight than the weight of such a roller having no bubbles of foam." The newly added language does not define any structural limitations.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al. [US 5,666,626] in view of Nishio et al. [JP 02296267A].

Takizawa et al. disclose a magnet roller [3] comprising a foamed mixture of resin and magnetic material [column 4, lines 32-53].

Takizawa et al. disclose the instant claimed invention except for the roller resin foam having no bubbles on the outside thereof.

Nishio et al. disclose a foamed toner carrier [7] having a smooth (no bubbles) surface [abstract].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the surface design of Nishio et al. for the roller of Takizawa et al. for the purpose of maintaining uniform hardness during the life of the roller.

Claims 2-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al., as modified, as applied to claim 1 above, and further in view of Ochiai et al. [US 5,565,966].

Regarding claims 2-4, 7 and 9-10 Takizawa et al., as modified, disclose the instant claimed invention except for the specific proportions of magnetic material to binder and the specific type of material.

Ochiai et al. disclose a magnet roller [40] formed of a material having at least 50-90% Sr (strontium) ferrite magnetic power resin [column 5, lines 12-40].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the material and the material ration of Ochiai et al. for the roller of Takizawa et al.; as modified, for the purpose of providing sufficient magnetic strength.

Regarding claims 5-6, Ochiai et al. further discloses the use of nylon-6 in the resin [column 7, line 53-column 8 line 2].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use nylon-6 in the resin of Takizawa et al., as modified, for the purpose of improving strength.

Regarding claim 8, Ochiai et al. further discloses the addition of carbon to the binder [column 5, lines 12-25].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include carbon in the filler of Takizawa et al., as modified, as further suggested by Ochiai et al., in order to improve conductivity.

### ***Response to Arguments***

Applicant's arguments filed 06-22-04 have been fully considered but they are not persuasive.

Applicant argues:

[1]: Takizawa does not suggest a roller having a limited amount of foam located internally so as to have unimpaired magnetic properties;

[2]: Nisho fails to teach the claimed smooth surface;

[3]: Nisho is nonanalogous; and

[4]: Nothing in the references is at all specific to a limit on the amount of foam.

Examiner disagrees:

Regarding [1] and [4]: Applicant has not claimed a specific limit or location of the foam on the roller.

Regarding [2]: Nisho teaches, as acknowledged by applicant in the arguments, the claimed smooth surface.

Regarding [3]: In response to applicant's argument that Nisho is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the

applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both applicant's claimed invention and Nisho are directed to rollers used in an imaging apparatus.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

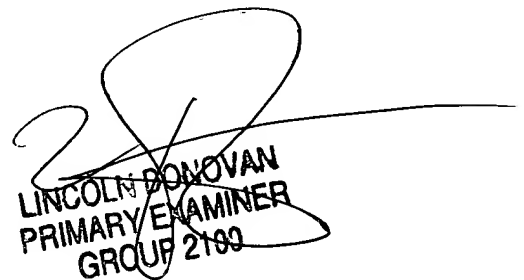
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lincoln Donovan whose telephone number is 571-272-1988. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ldd

  
LINCOLN DONOVAN  
PRIMARY EXAMINER  
GROUP 2100